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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HASHEM, LISA	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/086,338	RUCKART, JOHN P.	
	Examiner	Art Unit	
	Lisa Hashem	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

FINAL DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4-2-07 have been fully considered but they are not persuasive.

Applicant argues that Miner does not teach '...automatically answering the call if the call corresponds to the one or more parameters of the hold function and placing the call on hold...' and '...playing a message to the calling party that the call has been placed on hold...' as discloses in claims 6 and 17. Examiner disagrees. Miner clearly teaches determining the identity of the caller (e.g. calling party) based on information stored in a contact list and placing the call on hold if the caller has high priority (col. 8, lines 10-20; col. 32, line 65 – col. 33, line 54). Miner further discloses automatically answering the call or establishing a connection with the called party based on the priority associated with the caller identity and if the called party is accepting interruptions during an existing call (e.g. predetermined time period). Miner also teaches the electronic system plays a message to the calling party that the subscriber will be with him shortly and this implies the call is placed on hold until the talk path is established between the caller and the called party (col. 8, lines 55-59).

Claims 14-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Okun in view of Dutta in the Non-Final Office Action filed on 1-3-2007. The amendment discloses remarks including these claims being rejected over Okun in view of Novak. These claims were not rejected over Okun in view of Novak in the Non-Final Office Action filed on 1-3-2007. Therefore, Applicant's remarks regarding these rejections are invalid. The combination of Okun in view of Dutta clearly discloses the claimed invention wherein the hold feature of Okun is

modified to include a predetermined potential calling party as taught by Dutta. Dutta is evidence that calls from high priority callers are placed on hold until the called party can receive the call without disturbing others during a time period when the incoming call hold feature is activated.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6-13 and 17-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 5,652,789 by Miner et al, hereinafter Miner.

Regarding claim 6, Miner discloses a method of handling an incoming call to a telecommunications device (col. 20, lines 40-50; col. 29, lines 17-21; col. 30, lines 51-60; col. 32, lines 1-47) from a calling party to a called party, the method comprising:

receiving one or more parameters of a hold function,

wherein the parameters include at least one of a predetermined time period (e.g. during an existing call of a called party the called party will accept interruptions; a time when the called party is online) during which the incoming call is placed on hold, (e.g. waiting on the line for the called party to establish connection with the called party when the called party will accept interruptions) (col. 4, lines 16-26; col. 5, lines 47-57; col. 8, lines 25-59; col. 37, lines 38-56), and

a list (e.g. calling party's contact list) including at least one predetermined potential calling party (e.g. caller with high priority) from whom incoming calls are placed on hold (e.g. waiting on the line to connect with the called party when the called party is on another call or is online) (col. 8, lines 10-20; col. 32, line 65 – col. 33, line 54);

automatically answering the call (e.g. establishing connection to the called party; called party being notified of incoming call; called party accepts the call) if the call corresponds to the one or more parameters of the hold function and placing the call on hold (e.g. not disconnecting the call; call stored in queue; holding the call until the called party becomes available) (col. 32, lines 46-64; col. 33, lines 5-17 and lines 49-54; col. 34, lines 20-33 and lines 60-65; Fig. 24A: 500, 504, 516, 518, 522, 524, 528; col. 37, line 38-67);

playing a message to the calling party that the call has been placed on hold (col. 8, lines 50-59; col. 34, lines 8-12) and

connecting the called party to the calling party when the called party answers the call (col. 8, lines 50-59; col. 36, lines 44-51; Fig. 26: 614, 622; col. 37, lines 38-63; col. 38, lines 1-14 and lines 27-29; Fig. 24A: 524, 528; Fig. 27: 640, 644).

Regarding claim 7, the method of claim 6, wherein Miner further discloses determining whether the called party has enabled a hold function (col. 7, lines 51-65; col. 32, lines 54-64; col. 33, lines 14-54; col. 34, lines 60-65; col. 37, line 38 – col. 39, line 3).

Regarding claim 8, the method of claim 6, wherein Miner further discloses determining whether the called party has pressed a button on the telecommunications device to enable a hold function (col. 8, lines 36-59; col. 37, line 54 – col. 38, line 3).

Regarding claim 9, the method of claim 6, wherein Miner further discloses means for alerting the called party of the incoming call (col. 8, line 10-59; col. 36, lines 44-49; col. 38, lines 1-26).

Regarding claim 10, the method of claim 6, wherein Miner further discloses connecting the calling party to a voicemail system when the called party does not answer the call within a predetermined time period (col. 8, lines 60-63; col. 38, lines 15-26).

Regarding claim 11, the method of claim 6, wherein Miner further discloses playing a message to the calling party includes playing a message that is resident on a services node (e.g. a virtual machine) of a telecommunications network (Figs. 3 and 5) (col. 20, lines 40-50; col. 38, lines 15-26).

Regarding claim 12, the method of claim 6, wherein Miner further discloses playing a message to the calling party includes playing a pre-recorded message stored in a memory device resident on the telecommunications device (e.g. a virtual machine) (col. 8, lines 55-59; col. 20, lines 40-50; col. 38, lines 15-26).

Regarding claim 13, the method of claim 6, wherein Miner further discloses connecting the call to a voicemail system when the called party presses a button on the telecommunications device (col. 8, lines 60-63; col. 36, lines 47-60).

Regarding claim 21, the method of claim 6, wherein Miner further discloses the receiving one or more parameters of the hold function is performed via a web interface (col. 10, line 51 – col. 11, line 3; col. 11, lines 51-63; col. 16, lines 47-60; col. 17, lines 31-59; col. 19, lines 53-61; col. 33, lines 29-48; col. 37, lines 54-63).

Regarding claim 17, Miner discloses an apparatus (col. 20, lines 40-50; col. 29, lines 17-21; col. 30, lines 51-60; col. 32, lines 1-47), comprising:

means for receiving one or more parameters of a hold function,

wherein said parameters include at least one predetermined time period (e.g. during an existing call of a called party the called party will accept interruptions; a time when the called party is online) during which an incoming call is placed on hold (e.g. waiting on the line for the called party to establish connection with the called party when the called party will accept interruptions) (col. 4, lines 16-26; col. 5, lines 47-57; col. 8, lines 25-29; col. 37, lines 38-56), and

a list (e.g. calling party's contact list) including at least one predetermined potential calling party (e.g. caller with high priority) from whom incoming calls are placed on hold (e.g. waiting on the line to connect with the called party when the called party is on another call or is online) (col. 8, lines 10-20; col. 32, line 65 – col. 33, line 54);

means for automatically answering a call placed by a calling party to a called party (e.g. establishing connection to the called party; called party being notified of incoming call; called party accepts the call),

if the call corresponds to the one or more parameters and placing the call on hold (e.g. not disconnecting the call; call stored in queue; holding the call until the called party becomes available) (col. 32, lines 46-64; col. 33, lines 5-17 and lines 49-54; col. 34, lines 20-33 and lines 60-65; Fig. 24A: 500, 504, 516, 518, 522, 524, 528; col. 37, line 38-67);

means for playing a message to the calling party that the call has been placed on hold (col. 8, lines 50-59; col. 34, lines 8-12); and

means for connecting the called party to the calling party when the called party answers the call (col. 8, lines 50-59; col. 36, lines 44-51; Fig. 26: 614, 622; col. 37, lines 38-63; col. 38, lines 1-14 and lines 27-29; Fig. 24A: 524, 528; Fig. 27: 640, 644).

Regarding claim 18, the apparatus of claim 17, wherein Miner further discloses means for determining whether the called party has enabled a hold function (col. 7, lines 51-65; col. 32, lines 54-64; col. 33, lines 14-54; col. 34, lines 60-65; col. 37, line 38 – col. 39, line 3).

Regarding claim 19, the apparatus of claim 17, wherein Miner further discloses means for determining whether the called party has pressed a button on a telecommunications device to enable a hold function (col. 8, lines 36-59; col. 37, line 54 – col. 38, line 3).

Regarding claim 20, the apparatus of claim 17, wherein Miner further discloses means for alerting the called party of the incoming call (col. 8, lines 10-59; col. 36, lines 44-49; col. 38, lines 1-26).

Regarding claim 22, the apparatus of claim 17, wherein Miner further discloses the means for receiving one or more parameters of the hold function receives the one or more parameters via a web interface (col. 10, line 51 – col. 11, line 3; col. 11, lines 51-63; col. 16, lines 47-60; col. 17, lines 31-59; col. 19, lines 53-61; col. 33, lines 29-48; col. 37, lines 54-63).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okun in view of Dutta.

Regarding claim 14, Okun discloses a telecommunications system (see Figure 1a; section 0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (e.g. a subscriber profile indicates determining whether a text or voice message is preferred for a calling party in order to send a message to a calling party that is on hold) (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040, line 11; section 0044, lines 1-14; section 0077, lines 1-12);

a services node or serving MSC (Figure 1A, 118) for:

determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service, the determining based on an inopportune time period during which the incoming call is placed on hold (section 0011, lines 1-4); placing the incoming call on hold prior to the call being answered; playing a message to the calling party that the call has been placed on hold (section 0054, line 1 – section 0057, line 13); and

connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (section 0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure 1A, 102) for facilitating communication between the telecommunications device, the services node, and the home location register (section 0054, lines 5-12).

Okun clearly discloses determining whether an incoming call should be placed on hold prior to being answered. However, Okun does not disclose the determining based on a list including at least one predetermined potential calling party from whom incoming calls are placed on hold.

Dutta discloses a telecommunications system comprising:

a services node or Bluetooth server (col. 5, line 1 – col. 6, line 13; Figs. 5 and 6) for:

determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being answered by the user of the telecommunications device according to the incoming call hold service,

the determining based on at least one of a predetermined time period (e.g. when the user is in a theatre or concert hall and receives Bluetooth hold commands from a Bluetooth server; a timer is set up to detect the commands) during which the incoming call is placed on hold (col. 1, lines 29-37; col. 5, lines 25-33; col. 6, lines 2-13), and

a list including at least one predetermined potential calling party from whom incoming calls are placed on hold (col. 2, lines 21-36);

placing the incoming call on hold prior to the call being answered (col. 5, lines 7-14; col. 5, lines 60-67);

playing a message to the calling party that the call has been placed on hold; and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (col. 5, line 60 - col. 6, line 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the telecommunication system of Okun to include the determining based on a list including at least one predetermined potential calling party from whom incoming calls are placed on hold as taught by Dutta. One of ordinary skill in the art would have been lead to make such a modification in a service node to process calls from a caller with high priority in order to take urgent calls and place the call on hold until the called party is able to take the call without disturbing others. Dutta is evidence that calls from high priority callers are placed on hold until the called party can receive the call without disturbing others during a time period when the incoming call hold feature is activated.

Regarding claim 15, the system of claim 14 mentioned above, wherein Okun further discloses the services node includes an enunciator or IVR (section 0057, lines 5-9; section 0061, lines 10-14).

Regarding claim 16, the system of claim 15 mentioned above, wherein Okun further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (section 0057, lines 5-9; section 0061, line 10 – section 0062, line 10).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

8. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh
May 31, 2007

FAN TSANG
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